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EXAMINER
MARSCHEL, A

ART UNIT | PAPER NUMBER
1807 | 13

DATE MAILED: 11/19/91

WATSON T. SCOTT
CUSHMAN, DARBY & CUSHMAN
11TH FLR., 1615 L STREET, N. W.
WASHINGTON, DC 20036-5601

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 7/23/91 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-19 are pending in the application.
   Of the above, claims 8-15 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-7 and 16-19 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1800, Art Unit 1807.

Applicant's arguments filed 7/23/91 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

The amendment filed 7/23/91 has been entered. The deletions on pages 73-88 were difficult to understand since these correspond to pages of drawings but were not labeled as such in the amendment.

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts, compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary. As written the abstract is not descriptive of the DNA compositions claimed, only the methods and is thus incomplete. Complete revision of the content of the abstract is required on a separate sheet.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure.

The amendment filed 7/23/91 states on page 21 the support for T11 and TR4. Examination of the cited passages still shows that the content of clone T11 remains inadequately disclosed in that the page 45, lines 8-9, indicate that T11 encompasses nucleotides 1 through 3454 of Figure 3. This still conflicts with the Figure 2 disclosure that T11 terminates with EcoR I sites and the discussion that T11 only contains the exons designated in Figure 3 as a, b, and c. The citations of page 18, lines 8-23, and page 44, lines 3-9, are useless with regard to defining T11 or TR4 and only add confusion.

Applicants have stated in their amendment filed 7/23/91 that deposits of probes that distinguish the α and ß forms of PDGF receptor as well as a deposit for T11 is being pursued but is not yet completed. Since the clone and probes are essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the clone and probes are not so obtainable or available, the requirements of 35 USC 112 may be satisfied by deposits of the clone and probes. The specification does not

disclose a repeatable process to obtain the clone and probes and it is not apparent if the clone and probes are readily available to the public. It is noted that applicants have pursued depositing the clone and probes but there is no indication in the specification as to public availability. If the deposits are made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific strains have been deposited under the Budapest Treaty and that the strains will be irrevocably and without restriction or condition released to the public upon issuance of a patent, would satisfy the deposit requirement made herein.

If the deposits have not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in MPEP 608.01(p)C, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that:

(a) during pendency of this application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting the patent;

(c) the deposits will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the

patent, whichever is longer; and,

(d) the deposits will be replaced if they should ever become inviable.

Claims 1-7 and 16-19 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 1-7 and 16-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Note the above confusion as to the content of the T11 clone. What are the metes and bounds of T11 as required to practice the instant invention? Clarification to eliminate the many conflicts discussed above is requested.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The

faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

The CM1 Fax Center number is (703) 308-4227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

AM

A. MARSCHEL:am

November 18, 1991

Esther Kepplinger

ESTHER L. KEPPLINGER
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 1802